

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF FLORIDA  
MIAMI DIVISION

**YOKOHAMA RUBBER COMPANY LTD.,**)  
a Japanese corporation, and **YOKOHAMA**)  
**TIRE CORPORATION,** a California )  
corporation, )

Plaintiffs, )

v. )

**HANGZHOU ZHONGCE RUBBER CO.,**)  
**LTD.,** a Chinese corporation, )

Defendants. )

CASE NO. **08-20142**  
**CIV-ALTONAGA**  
MAGISTRATE JUDGE  
TURNOFF

**COMPLAINT FOR PATENT INFRINGEMENT**

Plaintiffs **Yokohama Rubber Company Ltd. ("Yokohama Rubber")** and **Yokohama Tire Corporation ("Yokohama Tire")**, by and through their attorneys, allege as follows:

**Jurisdiction and Venue**

1. This is a civil action for patent infringement, injunctive relief, and damages arising under the Acts of Congress relating to patents, 35 U.S.C. § 1 *et seq.* This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331 and 1338.

2. Venue is proper in this Judicial District pursuant to 28 U.S.C. §§ 1391(b), (c), (d), and 1400(b). Upon information and belief, Defendant has engaged in the complained of activities in this Judicial District.

**The Parties**

3. Plaintiff **Yokohama Rubber** is a corporation organized and existing under the laws of Japan, having its principal place of business in Tokyo, Japan.

4. Plaintiff **Yokohama Tire** is a wholly-owned subsidiary of **Yokohama Rubber**, organized and existing under the laws of the State of California and having its principal place of business at 601 South Acacia Avenue, Fullerton, California 92831.

5. On information and belief, Defendant Hangzhou Zhongce Rubber Co., Ltd. is a company organized and existing under the laws of the People's Republic of China, having a principal place of business at 527 Dengyun Road, Hangzhou City, Zhejiang Province, China P.R.C. 310011.

6. Plaintiffs are informed and believe, and on that basis allege, that Defendant has ongoing and systematic contacts with this Judicial District, and has placed the products accused of infringement herein into the stream of commerce knowing and expecting that such products would end up in this Judicial District.

**Allegations Common to All Claims for Relief**

7. Plaintiff Yokohama Rubber is one of the largest tire manufacturers in the world. Over thirty years ago, to meet the growing needs of the United States marketplace, Yokohama Rubber established Plaintiff Yokohama Tire in Southern California as its North American manufacturing and marketing arm. Today, Yokohama Tire maintains manufacturing capabilities and distribution centers throughout the United States, servicing a network of over 4500 points of sale for Yokohama tires nationwide.

8. On November 29, 2005, the United States Patent and Trademark Office duly and legally issued U.S. Patent No. D512,014 ("the '014 patent") to Yokohama Rubber as the assignee. Attached hereto as Exhibit 1 is a true and correct copy of the '014 patent. Yokohama Rubber is the owner of the entire right, title and interest in and to the '014 patent, and Yokohama Tire is exclusively licensed to sell tires covered by the '014 patent in the United States.

9. The '014 patent claims "the ornamental design for an automobile tire," which is shown and described in the '014 patent as the distinctive tire tread design that has become commonly known in the United States as the "S.drive" tire tread sold exclusively by Yokohama Tire.

10. Yokohama Tire introduced the S.drive tire in 2006. The S.drive tire is a premium high performance summer tire marketed generally to discerning customers who are willing to pay a premium price for an high performance tire that has the distinctive look and tread pattern of the S.drive. Yokohama Tire's customers purchase S.drive tires for their high-performance cars such as Mercedes-Benz, BMW, Lexus and Infinity, among others.

11. Since the S.drive was first introduced, Yokohama Tire has extensively advertised,

marketed and promoted the S.drive tire in the United States, including its unique tread pattern, which is distinctive in appearance, eye-catching and readily recognized among customers and members of the trade (hereinafter referred to as “the S.drive trade dress”).

12. Further examples of published and distributed materials used to advertise and promote the S.drive trade dress since its introduction include editorial coverage in Road & Track Magazine, Sport Compact Car Magazine, European Car Magazine and Euro Tuner Magazine.

13. The S.drive trade dress is arbitrary and distinctive. Since its introduction, the S.drive trade dress has also acquired secondary meaning and distinctiveness among consumers and members of the trade, and it continues to have secondary meaning and distinctiveness. The S.drive tire is now widely known and recognized by its unique and distinctive appearance, which identifies to consumers and members of the trade that the source of origin of the S.drive trade dress is Yokohama Tire.

14. The S.drive trade dress is non-functional.

15. By reason of the foregoing, the S.drive trade dress has become and is now a designation of origin of Yokohama Tire and a trademark owned by Yokohama Tire.

16. Defendant Hangzhou is engaged in the business of exporting and/or importing large quantities of tires into the United States, and it distributes its products in this Judicial District, in the State of Florida, and throughout the United States in interstate commerce, including tires sold under the “Stamford Sumo Firenza ST-08” and “Stamford Sumo Akina ST-08” name and brand.

17. Plaintiffs are informed and believe, and thereon allege, that Defendant Hangzhou manufactures the “Stamford Sumo Firenza ST-08” and “Stamford Sumo Akina ST-08” (collectively, “ST-08”) tires in China. Customers seeking the ST-08 tire may purchase it from wholesalers, retailers and/or individuals who buy the tires from Stamford.

#### **FIRST COUNT – PATENT INFRINGEMENT**

18. Plaintiffs hereby incorporate Paragraphs 1 through 16, inclusive, herein by reference.

19. On information and belief, Defendants have made, used, sold and/or offered for sale one or more tire products, including but not limited to the ST-08 tires, that infringe the ‘014 patent.

20. On information and belief, Defendants have induced others, including each other, to infringe the ‘014 patent by encouraging and promoting the importation, use, manufacture, sale and/or

offer for sale by others of infringing tire products, including but not limited to the ST-08 tires.

21. On information and belief, Defendants had notice and actual knowledge of the '014 patent before the filing of this suit, and Defendants' infringement of the '014 patent has been and continues to be willful and deliberate.

22. Plaintiffs have been damaged by Defendants' infringement of the '014 patent in an amount to be determined at trial, such damages including all of Defendants' profits from the infringement alleged herein. Furthermore, by these acts, Defendants have irreparably injured Plaintiffs and such injury will continue unless Defendants are enjoined by this Court.

### **SECOND COUNT—TRADE DRESS INFRINGEMENT**

23. Yokohama Tire hereby incorporates Paragraphs 1 through 21, inclusive, herein by reference.

24. To any ordinary observer, and to customers and members of the trade, the tread design of the ST-08 tire is confusingly similar, if not identical, to the S.drive trade dress, in particular the distinctive "look" of the S.drive tire, including its tread pattern, which is unique in appearance, eye-catching and readily recognized among customers and members of the trade.

25. Defendant's past, present and future importation of tires employing the S.drive trade dress, including but not limited to the ST-08 tire, constitutes trade dress infringement under 15 U.S.C. § 1125.

26. On information and belief, Defendant's trade dress infringement has been and continues to be willful and deliberate.

27. Yokohama Tire has been damaged by Defendant's trade dress infringement in an amount to be determined at trial. Furthermore, by these acts, Defendants have irreparably injured Yokohama Tire and caused Yokohama Tire to suffer a substantial loss of goodwill and reputation, and such injury will continue unless Defendants are enjoined by this Court.

28. By reason of the above actions, Yokohama Tire is entitled to the full range of relief under the Lanham Act, 15 U.S.C. §§ 1116-1118.

### **PRAYER FOR RELIEF**

WHEREFORE, Plaintiffs pray for judgment against Defendants as follows:

A. That Defendant be adjudged to have infringed the '014 patent;

B. That Defendant be adjudged to have induced infringement of the '014 patent;

C. That Defendant's patent infringement be adjudged willful and deliberate;

D. That this case be deemed exceptional under 35 U.S.C. § 285, and that the damages for patent infringement be enhanced accordingly;

E. That Defendant, their subsidiaries, affiliates, parents, successors, assigns, officers, agents, servants, employees, attorneys, and all persons acting in concert or in participation with Defendant be preliminarily and permanently enjoined from:

1. Infringing or inducing infringement of the '014 patent, and specifically from directly or indirectly making, using, selling, or offering for sale, any products embodying the invention of the '014 patent during its term, without the express written authority of Plaintiffs.

2. Passing off its goods and/or services as those of Yokohama Tire.

3. Engaging in any conduct aimed at or likely to result in diverting business intended for Yokohama Tire or injuring Yokohama Tire's goodwill or business reputation by way of imitation, misrepresentation, false statements, advertising, fraud and/or deception.

F. An order from this Court compelling Defendant to mail notice letters at their own expense to all distributors, dealers, accounts, salesmen, employees, jobbers, and suppliers, informing them that Defendant has committed patent infringement against Yokohama Tire and that Defendant has no affiliation, connection, or other business relationship with Yokohama Tire, requesting that they return to Defendant for full credit or refund all of Defendant's tires using the infringing design.

G. An order from this Court commanding that Defendant deliver to Yokohama Tire for destruction all advertising, products, labeling, packaging, sales/promotional literature, owner's manuals, catalogs, displays, boxes, packages, and other trade pieces within their possession or control and which use the infringing design.

H. An award of money damages suffered by Plaintiffs in an amount to be ascertained, and the trebling thereof.

I. A constructive trust imposed on all revenue, income and things of value derived by Defendant in manufacturing, importing, marketing and selling tires using imitative tread designs,

including the tread design complained of in Complaint.

J. Judgment, relief, and requests as set forth in this Complaint.

K. Reasonable attorney's fees, prejudgment interest, and costs of this action.

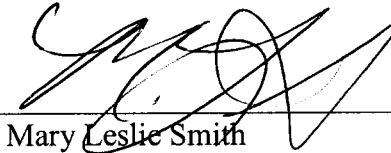
L. All such other, further, and different relief as the court deems proper under the circumstances.

### DEMAND FOR JURY TRIAL

Pursuant to Fed. R. Civ. P. 38(b), Plaintiffs **Yokohama Rubber Company Ltd.** and **Yokohama Tire Corporation** hereby demand a trial by jury of all issues so triable.

Respectfully submitted,

Dated: January 17<sup>th</sup>, 2008



Mary Leslie Smith  
Florida Bar No.: 774243  
**FOLEY & LARDNER LLP**  
100 S.E. Second Street  
Suite 1600  
Miami, Florida 33131  
Telephone: 305.482.8406  
Facsimile: 305.482.8400  
E-mail: mlsmith@foley.com  
William J. Robinson (State Bar No. 83729)  
*(Will Seek Pro Hac Vice Admission)*  
E-mail: wjrobinson@foley.com  
Lori V. Minassian (State Bar No. 223542)  
*(Will Seek Pro Hac Vice Admission)*  
E-mail: lminassian@foley.com  
Diana Chen (State Bar No. 232921)  
*(Will Seek Pro Hac Vice Admission)*  
E-mail: dchen@foley.com  
555 South Flower Street, 35<sup>th</sup> Floor  
Los Angeles, California 90071  
Telephone: 213.972.4500  
Facsimile: 213.486.0065  
Attorneys for Plaintiffs  
**YOKOHAMA RUBBER COMPANY LTD.**  
and **YOKOHAMA TIRE CORPORATION**

# EXHIBIT 1



US00D512014S

(12) **United States Design Patent** (10) **Patent No.:** **US D512,014 S**  
**Ishida et al.** (45) **Date of Patent:** **\*\* Nov. 29, 2005**

(54) **AUTOMOBILE TIRE**

D452,667 S \* 1/2002 Tsubono ..... D12/554

D485,229 S \* 1/2004 Murata ..... D12/556

D489,317 S \* 5/2004 Yamane et al. .... D12/550

(75) Inventors: **Masahiro Ishida**, Kanagawa (JP);  
**Hirohisa Hazama**, Kanagawa (JP);  
**Hiroshi Tokizaki**, Tokyo (JP);  
**Koutarou Iwabuchi**, Tokyo (JP); **Izumi Kuramochi**, Tokyo (JP)

\* cited by examiner

*Primary Examiner*—Robert M. Spear(74) *Attorney, Agent, or Firm*—Rader, Fishman & Grauer P.L.L.C.

(73) Assignee: **The Yokohama Rubber Co., Ltd.**,  
Tokyo (JP)

(57) **CLAIM**(\*\*) Term: **14 Years**

The ornamental design for automobile tire, as shown and described.

(21) Appl. No.: **29/211,237****DESCRIPTION**(22) Filed: **Aug. 13, 2004**(30) **Foreign Application Priority Data**

Feb. 18, 2004 (JP) ..... 2004-004115

(51) **LOC (8) Cl.** ..... **12-15**(52) **U.S. Cl.** ..... **D12/550**

(58) **Field of Search** ..... D12/547, 549,  
D12/550, 553, 554, 555, 556, 558, 559,  
560, 561, 563, 564, 565, 566, 567, 579,  
586, 588, 589, 590, 591, 602, 603; 152/209.01,  
209.08, 209.09, 209.18, 209.25, 209.28

FIG. 1 is a front view of an automobile tire, showing the new design, a top plan view thereof and a bottom plan view thereof appearing the same as the front view;

FIG. 2 is a rear view of the automobile tire;

FIG. 3 is a right side view of the automobile tire;

FIG. 4 is a left side view of the automobile tire;

FIG. 5 is a fragmentary front view, showing in enlargement the portion of 5—5 in FIG. 1;

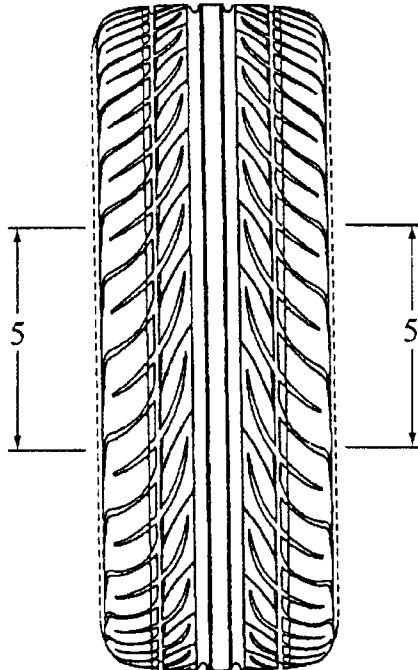
FIG. 6 is a cross-sectional view, taken along line 6—6 and in the direction of arrows in FIG. 5; and,

FIG. 7 is a perspective view of the automobile tire.

The broken line showing of a sidewall and inner bead represents environmental structure only and form no part of the claimed design.

(56) **References Cited****U.S. PATENT DOCUMENTS**

D397,973 S \* 9/1998 Morishita et al. .... D12/556

**1 Claim, 3 Drawing Sheets**



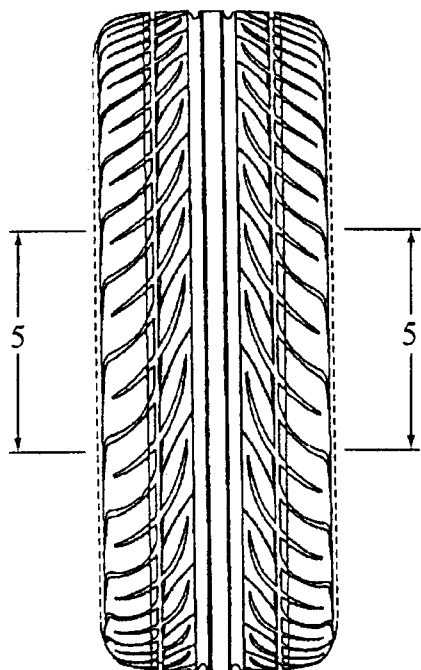
**U.S. Patent**

**Nov. 29, 2005**

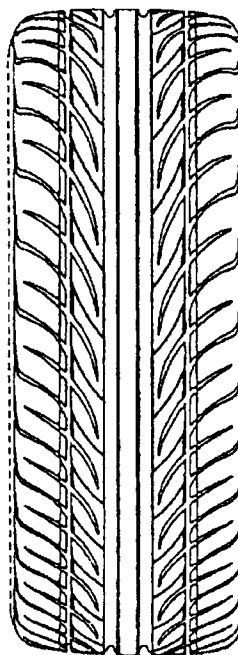
**Sheet 1 of 3**

**US D512,014 S**

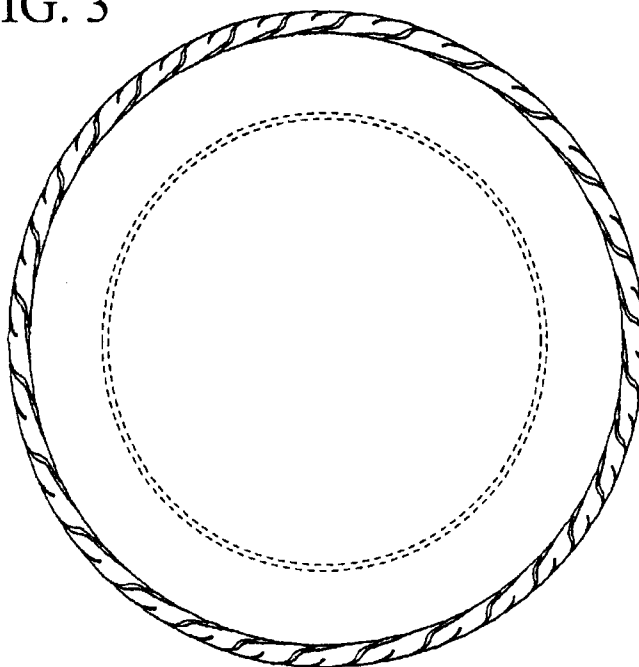
**FIG. 1**



**FIG. 2**



**FIG. 3**



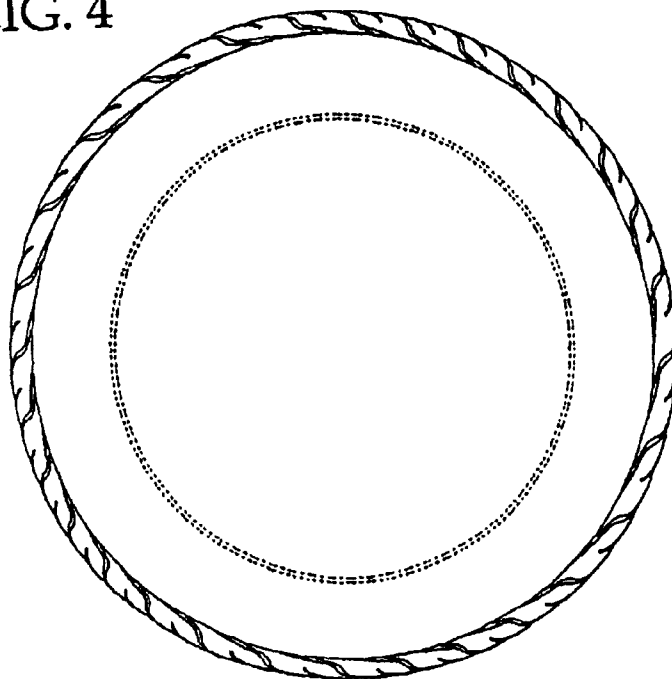
**U.S. Patent**

Nov. 29, 2005

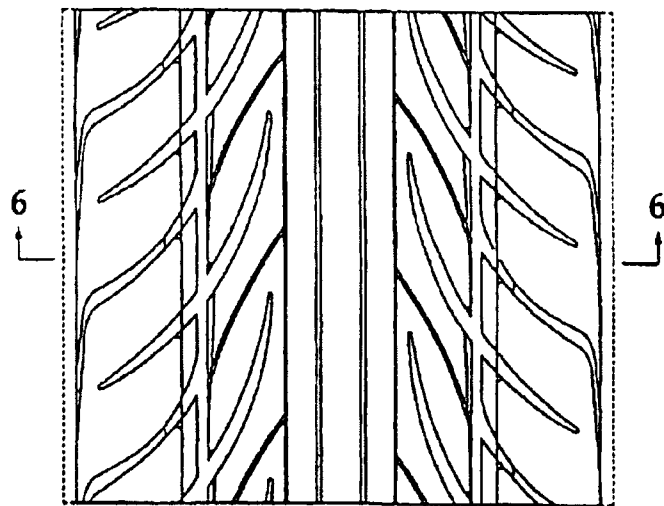
Sheet 2 of 3

**US D512,014 S**

**FIG. 4**



**FIG. 5**



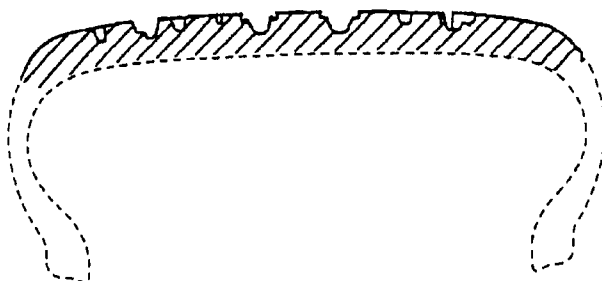
**U.S. Patent**

Nov. 29, 2005

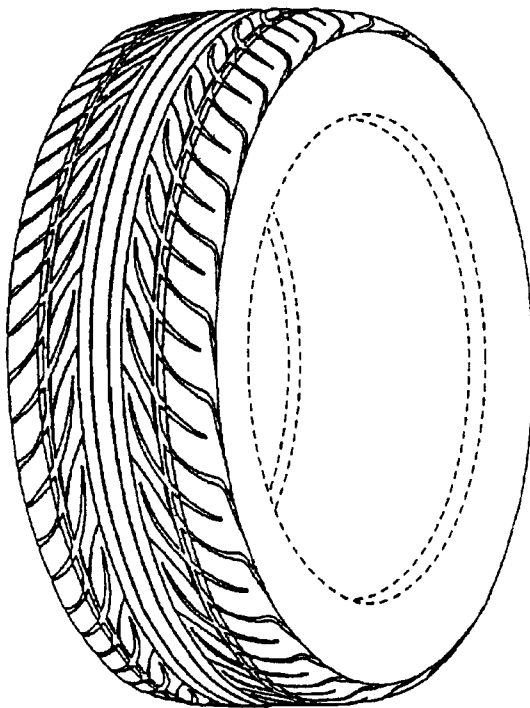
Sheet 3 of 3

**US D512,014 S**

**FIG. 6**



**FIG. 7**



## CIVIL COVER SHEET

08-20142

the JS-44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleading or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON THE REVERSE OF THE FORM).

<b>(a) PLAINTIFFS</b> YOKOHAMA RUBBER COMPANY and YOKOHAMA TIRE CORPORATION		<b>DEFENDANTS</b> HANGZHOU ZHONGCE RUBBER CO., LTD.	
<b>(b) County of Residence of First Listed Plaintiff</b> <b>JAPAN</b> (EXCEPT IN U.S. PLAINTIFF CASES)		<b>County of Residence of First Listed Defendant</b> <b>CHINA</b> (IN U.S. PLAINTIFF CASES ONLY) Note: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE TRACT OF LAND INVOLVED	
<b>(c) Attorneys (Firm Name, Address, And Telephone Number)</b> Mary Leslie Smith, Foley & Lardner, LLP, Suite 1600 Bank of America Tower, 100 S.E. 2 <sup>nd</sup> Street, Miami, FL 33131 (305.482.8406)		<b>Attorneys (If known)</b> CIV - ALTONAGA MAGISTRATE JUDGE TURNOFF	
<b>(d) CIRCLE COUNTY WHERE ACTION AROSE:</b> MIAMI-DADE, MONROE, BROWARD, PALM BEACH, MARTIN, ST. LUCIE, INDIAN RIVER, OKEECHOBEE, HIGHLANDS			
<b>I. BASIS OF JURISDICTION</b> (Place an X in one box only)		<b>III. CITIZENSHIP OF PRINCIPAL PARTIES</b> (Place an X in one box for Plaintiff and one box for Defendant)	
<input type="checkbox"/> 1 U.S. Government Plaintiff <input type="checkbox"/> 2 U.S. Government Defendant <input checked="" type="checkbox"/> 3 Federal Question (U.S. Government Not a Party) <input type="checkbox"/> 4 Diversity (Indicate Citizenship of Parties in item III)		Citizen of this State <input type="checkbox"/> 1 <input type="checkbox"/> 1 Incorporated of Principal Place of Business in This State <input type="checkbox"/> 4 <input type="checkbox"/> 4 Citizen of another State <input type="checkbox"/> 2 <input type="checkbox"/> 2 Incorporated and Principal Place of Business in Another State <input type="checkbox"/> 5 <input type="checkbox"/> 5 Citizen or subject of a foreign Country <input checked="" type="checkbox"/> 3 <input checked="" type="checkbox"/> 3 Foreign Nation <input type="checkbox"/> 6 <input type="checkbox"/> 6	
<b>V. NATURE OF SUIT (PLACE AN X IN ONE BOX ONLY)</b>			
<b>CONTRACT</b> <input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability <input type="checkbox"/> 196 Franchise		<b>TORTS</b> <b>PERSONAL INJURY</b> <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury <b>PERSONAL INJURY</b> <input type="checkbox"/> 362 Personal Injury—Med. Malpractice <input type="checkbox"/> 365 Personal Injury—Product Liability <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability <b>PERSONAL PROPERTY</b> <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability	
<b>REAL PROPERTY</b> <input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure B <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property		<b>FORFEITURE/PENALTY</b> <input type="checkbox"/> 610 Agriculture <input type="checkbox"/> 620 Other Food & Drug <input type="checkbox"/> 625 Drug Related Seizure of Property <input type="checkbox"/> 630 Liquor Laws <input type="checkbox"/> 640 R.R. & Truck <input type="checkbox"/> 650 Airline Regs <input type="checkbox"/> 660 Occupational Safety/Health <input type="checkbox"/> 690 Other <b>LABOR</b> <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Mgmt. Relations <input type="checkbox"/> 730 Labor/Mgmt. Reporting & Disclosure Act <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Employee Ret. Inc Security Act	
<b>CIVIL RIGHTS</b> <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing/Accommodations <input type="checkbox"/> 444 Welfare <input type="checkbox"/> 445 American w/Disabilities-Employment <input type="checkbox"/> 446 American w/Disabilities-Other <input type="checkbox"/> 440 Other Civil Rights		<b>PRISONER PETITIONS</b> <input type="checkbox"/> 510 Motions to Vacate Sentence <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition	
<b>VI. ORIGIN</b> (PLACE AN X IN ONE BOX ONLY)		<b>BANKRUPTCY</b> <input type="checkbox"/> 422 Appeal 28 U.S.C. 158 <input type="checkbox"/> 423 Withdrawal 28 U.S.C. 157 <b>PROPERTY RIGHTS</b> <input type="checkbox"/> 820 Copyrights <input type="checkbox"/> 830 Patent <input type="checkbox"/> 840 Trademark <b>SOCIAL SECURITY</b> <input type="checkbox"/> 861 HIA (1395ff) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSID Title XVI <input type="checkbox"/> 865 RSI (405(g)) <b>FEDERAL TAX SUITS</b> <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS — Third Party U.S.C. 7609	
<input checked="" type="checkbox"/> 1 Original Proceeding <input type="checkbox"/> 2 Removed from State Court <input type="checkbox"/> 3 Remanded from Appellate Court <input type="checkbox"/> 4 Re-filed		<input type="checkbox"/> 6 Multidistrict Litigation <input type="checkbox"/> 7 Judge from Magistrate Judgment <input type="checkbox"/> 900 Appeal of Fee <input type="checkbox"/> 950 Determination Under Equal Access to Justice Constitutionality of State Statutes	
<b>VI. RELATED/RE-FILED CASE(S)</b> (See instructions second page)		a) Re-filed Case <input type="checkbox"/> YES <input checked="" type="checkbox"/> NO b) Related Cases <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No	
<b>VII. CAUSE OF ACTION</b> (CITE THE U.S. CIVIL STATUTE UNDER WHICH YOU ARE FILING AND WRITE A BRIEF STATEMENT OF CAUSE (DO NOT CITE JURISDICTIONAL STATUTES UNLESS DIVERSITY.) 35 USC § 1 et. seq. Length of Trial via 4 – 6 days estimated (for both sides) to try entire case		JUDGE DOCKET NUMBER	
<b>VIII. REQUESTED IN COMPLAINT:</b> <input type="checkbox"/> CHECK IF THIS IS A CLASS ACTION <input type="checkbox"/> UNDER F.R.C.P. 23		<b>DEMAND INJUNCTIVE RELIEF AND DAMAGES</b> JURY DEMAND: <input checked="" type="checkbox"/> YES <input type="checkbox"/> NO	
ABOVE INFORMATION IS TRUE & CORRECT TO THE BEST OF MY KNOWLEDGE SIGNATURE OF ATTORNEY OF RECORD: <i>Mary Leslie Smith</i> DATE: JANUARY 17, 2008 MARY LESLIE SMITH, FLA. BAR NO. 774243			
FOR OFFICE USE ONLY: AMOUNT Receipt# IFP \$350.00 993400 01/17/08			